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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,821	09/24/2003	Charles L. Cunningham	15923/09011 DIV	5175
27530	7590	05/06/2004	EXAMINER	
NELSON MULLINS RILEY & SCARBOROUGH LLP			WALSH, BRIAN D	
P.O. BOX 11070			ART UNIT	
COLUMBIA, SC 29211			PAPER NUMBER	

3722

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/669,821

Applicant(s)

CUNNINGHAM ET AL.

Examiner

Brian D. Walsh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant discloses in claim 4 that alignment occurs independent of a rotational speed of the wheel hub. Since Applicant explicitly states that the hub must rotate to perform the alignment, the invention is not disclosed in such a way that one of ordinary skill in the art could make and use an apparatus to meet claims 4 and 5.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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2. Claims 1 – 3 and 6 – 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Newell et al (U.S. Pat. No. 6,101,911).

Regarding claims 1 and 6, Newell et al. discloses an apparatus and a method for “on-the-fly” alignment of a wheel hub mounted brake lathe for machining a disc brake rotor on a vehicle comprising (a) mounting the brake lathe on a wheel hub of the vehicle, (b) rotating the wheel hub and the disc brake rotor by driving the wheel hub with the brake lathe and (c) manually adjusting an alignment of the brake lathe relative to the wheel hub and the disc brake rotor (col. 3, lines 12 – 48).

Regarding claims 2, 3, 6 and 9, Newell et al. discloses the apparatus can use servo-motors (852, figure 35) to make the adjustment as opposed to the “star” like gear/plane system. (Hydraulic actuators are known to be a subset of the general “servo motor” group). Newell discloses that the adaptor is to be rotated with the rest of the device, so it is inherent that the servo-motors are rotated along with the adaptor.

Regarding claim 7, Newell et al. discloses the pistons (852) can be adjusted independently of on another so it is inherent that the hydraulic system for each piston can be manually adjusted. Generally, automated machining systems are capable of manual interaction.

Regarding claim 8, Newell et al. discloses up to four adjustable extenders (852) that can be individually adjusted (col. 23, lines 1 – 5).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newell.

Regarding claim 4, Newell discloses an automatic system that can employ hydraulic actuators for adjusting an alignment of the brake lathe relative to the wheel hub and rotor.

Regarding claim 5, Newell discloses up to four adjustable extenders (852) that can be individually adjusted (col. 23, lines 1 – 5).

However, Newell does not explicitly state that the speed of alignment can occur at a speed independent or a rotational speed of the hub.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the adjustment device of Newell to be manual as opposed to being automatic since it has been held that alternating between manual and mechanical or automatic means to accomplish the same result involves only routine skill in the art. Furthermore, it is generally accepted that where a device is designed to be capable of automatic operation, manual operation is usually provided as well. This is further evident that Applicant discloses the instant invention could easily be made to be automatic with the use of a sensor.

#### **Faxing of Responses to Office Actions**

4. In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to all Office Actions directly into the Group at (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the Examiner

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and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the Examiner.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Walsh whose telephone number is (703) 605-0638. The examiner can normally be reached on Monday - Friday 8:30 A.M. to 6:00 P.M., with every-other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (703) 308-2159.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



BDW  
May 3, 2004



A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700